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09/965,405	09/26/2001	Tami L. Guy	10013329-1	3798

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EXAMINER

LANEAU, RONALD

ART UNIT PAPER NUMBER

3627

DATE MAILED: 05/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/965,405

Applicant(s)

GUY ET AL.

Examiner

Ronald Laneau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. In view of the decision by the board of patents appeals and interferences filed on November 22, 2005, PROSECUTION IS HEREBY REOPENED. The rejections cited are as stated below:

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. Claims 1-23 are presented for examination.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to nothing more than abstract ideas. To be legible for a patent, claims that set forth subject matter excluded by a judicial exception (i.e. abstract idea) must be for a practical application. A practical

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application results if the claimed invention transforms an article or physical object to a different state or thing or if the claimed invention produces a useful, concrete or tangible result. However, claims 1-23 fail to transform an article or physical object to a different state or thing and the claimed invention as shown by claims 1-23 fail to produce a useful, concrete or tangible result as discussed in detail below.

As to claim 1, the claim is directed to a method of doing business comprising entering into a contract relationship between organizations and authorizing the various entities to perform certain functions. However, the claim is not directed to processing an order or transaction. The claim recites various duties and obligations of the organizations that are parties to the contract. It does not appear that the claim is directed to a practical application of a judicial exception. In order for the claim to be directed to a practical application of a judicial exception, a useful, concrete and tangible result is produced. In order for the claim to be tangible the claim must set forth a practical application to produce a real world result. If the result is merely a thought, this is not a tangible or real world result. In claim 1, the claim is directed to various conditions that must be met in order for organizations to carry out various functions. The claim does not produce a real world result. Therefore, the claim is non statutory.

As to claims 2-12, the claim limitations are directed to additional conditions and functions that are to be performed if the conditions are satisfied. The claims do not produce a real world result. Therefore, the claims are non statutory.

As to claim 13, the claim is directed to a method of doing business comprising establishing requirements for organizations regarding the sale of items and listing the

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various responsibilities of each of the organizations. However, the claim is not directed to processing an order or transaction. The claim is directed to various conditions that must be met in order for organizations to carry out various functions. The claim does not produce a real world result. Therefore, the claim is non statutory.

As to claims 14-17, the claim limitations are directed to additional conditions and functions that are to be performed if certain conditions are satisfied. The claims do not produce a real world result. Therefore, the claims are non statutory.

As to claim 18, the claim is directed to a method of doing business comprising establishing requirements for organizations regarding the sale of items, listing the various responsibilities of each of the organizations and notification requirements for each of the organizations if certain conditions are met. However, the claim is not directed to processing an order or transaction. The claim does not produce a real world result. Therefore, the claim is non statutory.

As to claim 19, the claim is directed to a method of doing business comprising. Determining whether an organization providing services has completed the service , determining the types of services provided or to be provided and determining a billing strategy based on this determination. However, the claim is not directed to processing a bill for an order or transaction. The claim does not produce a real world result. Therefore, the claim is non statutory.

As to claims 20-23, the claim limitations are directed to additional conditions that are applied in order to determine the billing strategy. However, the claims are not

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directed to processing a bill for an order or transaction. The claims do not produce a real world result. Therefore, the claim is non statutory.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 13 is rejected under 35 U.S.C. 102(e) as being anticipated by Sharp et al. (hereinafter Sharp), Pat. No. 6,263,317.

As to claim 13, Sharp discloses a method for a first organization to do business comprising:

requiring a second organization to take an order for sales items on behalf of the first organization (i.e. supplier)(col. 3, lines 20-25);

in response to a determination that the order includes a product distributed by a third organization sending an order for that product to the third organization (i.e. alternative supplier with available inventory)(col. 5, lines 29-55);

requiring the third organization to ship the product directly to a customer's address (i.e. distribution channel actually used to ship the product)(col. 4, lines 36-55).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1- 6 and 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sharp et al. (hereinafter Sharp), Pat. No. 6,263,317 in view of Radosevich et al., "IT eyes reseller channel change"(hereinafter Radosevich).

As to claim 1, Sharp discloses a method for a first organization to do business comprising:

authorizing said second organization to take an order from a customer (i.e. supplier)(col. 3, lines 20-25);

receiving payment directly from said customer as a payment for said order taken by said second organization (col. 4, lines 2-4);

requiring an organization other than said first organization to ship products not produced by said first organization to said customer (i.e. distribution channel actually used to ship the product)(col. 4, lines 36-55).

Sharp does not explicitly disclose

entering into a contractual relationship with a second organization;

said order comprising at least one of:

products not produced by said first organization, and services not provided by said first organization

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requiring an organization other than said first organization to provide services to said customer.

However, Radosevich discloses entering into a contractual relationship with a second organization (i.e. reseller agreements)(page 1). Radosevich also discloses said order comprising at least one of: products not produced by said first organization, and services not provided by said first organization (i.e. value added services)(see abstract). Finally, Radosevich discloses requiring an organization other than said first organization to provide services to said customer (i.e. resellers ... value added services)(see abstract). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations as disclosed by Radosevich within Sharp for the motivation of offering additional services not offered by direct sellers thereby providing an incentive and increased choices for customers (i.e. post deployment help)(page 2, paragraphs 15 and 31).

As to claim 2, Sharp does not explicitly disclose The method of claim 1 and further comprising: requiring said second organization to provide a second organization service to a customer.

However, Radosevich discloses requiring said second organization to provide a second organization service to a customer (i.e. value added services)(abstract and paragraphs 15 and 17). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations as disclosed by Radosevich within Sharp for the same motivation as for claim 1 above.

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As to claim 3, Sharp does not explicitly disclose the method of claim 1 and further comprising:

requiring a third organization to provide a third organization service to said customer.

However, Radosevich discloses requiring an organization other than said first organization to provide services to said customer (i.e. resellers ... value added services)(see abstract). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations as disclosed by Radosevich within Sharp for the motivation stated for claim 1 above.

As to claim 4, Sharp discloses the method of claim 1 and further comprising: requiring a third organization to ship a third organization product to said customer (i.e. alternative supplier with available inventory)(col. 5, lines 29-55).

As to claim 5, Sharp discloses the method of claim 4 wherein said requiring a third organization to ship comprises requiring said third organization to ship said third organization product from a facility not controlled by said first organization (col. 5, lines 5-17).

As to claim 6, Sharp discloses the method of claim 4 and further comprising: verifying that said third organization product was received by said customer (col. 8, lines 58-64).

As to claim 8, Sharp discloses the method of claim 1 and further comprising: tracking receipt of said payment by computer (col. 4, lines 2-8).

As to claim 9, Sharp discloses the method of claim 1 and further comprising:

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paying said second organization a predetermined amount based on said order (col. 4, lines 1-8).

As to claim 10, Sharp discloses the method of claim 9 and further comprising: tracking said paying said second organization by computer (col. 4, lines 1-8).

As to claim 11, Sharp discloses the method of claim 4 and further comprising: paying said third organization for said third organization product (col. 4, lines 1-8).

As to claim 12, Sharp discloses the method of claim 11 and further comprising: tracking said paying said third organization by computer (col. 4, lines 1-8).

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sharp and Radosevich as applied to claim 1 above, and further in view of Hogan, Pub. No. 2001/0002464.

As to claim 7, Sharp and Radosevich do not explicitly disclose the method of claim 3 and further comprising: verifying that said third organization service was performed by said third organization.

However, Hogan discloses verifying that the service was performed by the organization (paragraphs 38 and 41). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations as disclosed by Hogan within the Sharp and Radosevich combination for the motivation of automating equipment servicing and task management to allow access to maintenance reports (paragraph 12).

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9. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sharp as applied to claim 13 above, and further in view of Carpenter et al., Pat. No. 6,868,401 (hereinafter Carpenter).

As to claim 14, Sharp does not explicitly disclose The method of claim 13 further comprising:

requiring the third organization to notify the second organization when the product has been shipped.

However, Carpenter discloses notifying a parties to a transaction when a product has been shipped (col. 7, line 39 – col. 8, line 44). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed in Carpenter within Sharp for the motivation of processing transactions through a computer network and tracks transaction through to completion (col. 2, lines 8-15)

As to claim 15, Sharp does not explicitly disclose The method of claim 14 further comprising: invoicing the customer after the third organization notifies the second organization that the product has been shipped.

However, Carpenter discloses invoicing the customer after the physical transfer of the property has been completed. In addition, parties to the transaction are notified of the their financial obligations (col. 5, lines 7-20).). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed in Carpenter within Sharp for the motivation of processing

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transactions through a computer network and tracks transaction through to completion (col. 2, lines 8-15).

10. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sharp and Carpenter as applied to claim 14 above, and further in view of Work et al., Pub. No. 2002/0007302 (hereinafter Work).

As to claim 16, Sharp does not explicitly disclose The method of claim 14 wherein the product shipped by the third organization is less than all items distributed by the third organization that were on the order and further comprising: requiring the third organization to notify the second organization when the order is incomplete and when the backlog for items on the order that were not shipped is longer than a predetermined number of days.

However, Work discloses requiring the third organization to notify the second organization when shipment of the product includes less than all items on order and the order is incomplete (i.e. improper fill rates ... shortages)(paragraphs, 44, 45, 48, and 65) and when the backlog for items on the order that were not shipped is longer than a predetermined number of days (paragraphs, 44, 45, 48, and 65). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed in Work within Sharp for the motivation of tracking vendor compliance with guidelines imposed on distributors, senders, shippers and the like in a supply chain (paragraph 8).

11. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sharp as applied to claim 13 above, and further in view of Work.

As to claim 17, Sharp does not explicitly disclose the method of claim 13 further comprising: requiring the second organization to notify the first organization when the order is incomplete and when the backlog for items on the order that were not shipped is longer than a predetermined number of days.

However, Work discloses requiring the second organization to notify the first organization when the order is incomplete (i.e. improper fill rates ... shortages)(paragraphs, 44, 45, 48, and 65) and when the backlog for items on the order that were not shipped is longer than a predetermined number of days (paragraphs, 44, 45, 48, and 65). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed in Work within Sharp for the motivation of tracking vendor compliance with guidelines imposed on distributors, senders, shippers and the like in a supply chain (paragraph 8).

12. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sharp in view of Bremers, Pat. No. 6,901,380.

As to claim 18, Sharp discloses a method for a first organization to do business comprising:

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requiring a second organization to take an order for sales items on behalf of the first organization (i.e. supplier)(col. 3, lines 20-25);

in response to a determination that the order includes a product distributed by a third organization sending an order for that product to the third organization (i.e. alternative supplier with available inventory)(col. 5, lines 29-55).

Sharp does not explicitly disclose

requiring the third organization to notify the first organization when the order exceeds a predetermined credit limit of the second organization.

However, Bremers discloses processing business transactions, determining if the order exceeds a predetermined credit limit and presenting the transaction to a user for resolution (i.e. authorizing a higher credit limit)(col. 9, lines 10-20). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed in Bremers within Sharp for the motivation of a system that provides feedback representing purchase order or customer information changes (col. 2, lines 35-45).

13. Claims 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan in view of Radosevich.

As to claim 19, Hogan discloses A method for a first organization to do business comprising:

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in response to a determination that services in a service order is incomplete determining whether the service order includes support services (i.e. technician completes service at customer site ... technician downloads completed work orders ... completed work orders are transferred to the billing and collection system to generate invoices. The Examiner interprets work orders that are not completed or incomplete will be invoiced upon completion)(paragraphs 33, 36, and 41) and determining a billing strategy based upon whether or not the service order includes support services (paragraphs 33, 36 and 41)(work orders that are not completed or incomplete will be invoiced upon completion. The Examiner further interprets that since the technician is servicing computer equipment, the technician provides support services).

Hogan does not explicitly disclose

the service order taken by a second organization on behalf of the first organization.

However, Radosevich discloses entering into a contractual relationship with a second organization (i.e. reseller agreements)(page 1). Radosevich also discloses said order comprising services not provided by said first organization (i.e. value added services)(see abstract). Finally, Radosevich discloses requiring an organization other than said first organization to provide services to said customer (i.e. resellers ... value added services)(see abstract). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations as disclosed by Radosevich within Hogan for the motivation of offering additional services

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not offered by direct sellers thereby providing an incentive and increased choices for customers (i.e. post deployment help)(page 2, paragraphs 15 and 31).

As to claim 20, Hogan discloses The method of claim 19 and further comprising: in response to a determination that the service order does not include support services determining whether the services ordered may be completed in less than a predetermined period of time (i.e. any type of service done to a particular unit)(paragraphs 28 and 33); and determining a billing strategy based upon whether or not the services ordered may be completed in less than a predetermined period of time (paragraphs 33, 36 and 41)(work orders that are not completed or incomplete by the end of the day will be invoiced upon completion).

As to claim 21, Hogan discloses The method of claim 20 wherein it is determined that the services ordered may not be completed in less than the predetermined period of time and further comprising determining whether the services ordered are essential to the use of hardware included on the order (i.e. any type of service done to a particular unit)(paragraphs 28 and 33).

As to claim 22, Hogan discloses The method of claim 21 wherein it is determined that the services ordered are essential to the use of hardware included on the order and further comprising waiting for completion of the service before invoicing either the service or hardware portion of the order (i.e. any type of service done to a particular unit)(paragraphs 28 and 33).

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14. Claim 23 rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan and Radosevich as applied to claim 21 above, and further in view of Carpenter.

As to claim 23, Hogan discloses The method of claim 21 wherein it is determined that the services ordered are not essential to the use of hardware included on the order and further comprising d (i.e. any type of service done to a particular unit)(paragraphs 28 and 33).

Hogan and Radosevich do not explicitly disclose invoicing the hardware portion of the order prior to completion of the services ordered.

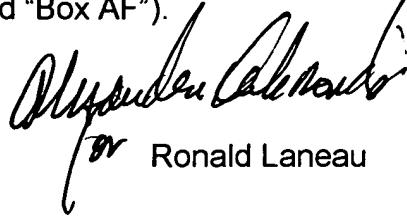
However, Carpenter discloses invoicing the customer after the physical transfer of the property has been completed. In addition, parties to the transaction are notified of the their financial obligations (col. 5, lines 7-20).). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed in Carpenter within Hogan and Radosevich for the motivation of processing transactions through a computer network and tracks transaction through to completion (col. 2, lines 8-15).

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau, whose telephone number is (571) 272-6784. The examiner can normally be reached on Monday to Friday from 7:00 AM to 3:30 PM. If any attempt to reached the examiner by telephone is unsuccessful, the examiner's supervisor, Alexander Kalinowski, can be reached on (571) 272-6771. The

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fax telephone number for this group is (571) 273-8300 (for official communications including After Final communications labeled "Box AF").

A handwritten signature in black ink, appearing to read "Ronald Laneau", with a stylized flourish extending from the end.

for Ronald Laneau

Primary Examiner

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A handwritten signature in black ink, appearing to read "Wynn W. Coggins", with a stylized flourish extending from the end.
WYNN W. COGGINS
TECHNOLOGY CENTER DIRECTOR